

Remarks and Arguments

Applicants have carefully considered the Office Action dated October 21, 2004 and the references cited therein. Applicants respectfully request reexamination and reconsideration of the application.

Claims 13-19, 25, and 27-54 are currently pending in the subject application.

Claims 13-19, 25, 27-29, 31-36, 38-39, 41-50, and 52-54 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of copending Patent Application Serial No. 10/646,095, and claims 1-35 of copending Patent Application Serial No. 10/647,705, both by the same inventors. In setting forth the provisional double patenting rejections, the Examiner has stated that although the conflicting claims are not identical, they are not patentably distinct from each other because the independent claims of the '095 and '705 applications recite all the limitations of the instant application which in compasses the same "metes and bounds". Finally, the Examiner has indicated that the rejection is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant respectfully traverses the provisional rejection of claims under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims on the grounds that claims 13-19, 25, 27-29, 31-36, 38-39, 41-50, and 52-54 are patentably distinct from the currently pending claims in either be '095 and '705 applications. In setting forth the rejection, the Examiner has admitted that conflicting claims are not identical. Indeed, each of the independent claims of the subject application recite different limitations, and, therefore, have distinctly different scope from that either be '095 and '705 applications. The examiner will note that each of the '095 and '705 applications are continuation-in-part applications of the subject application and have filing dates subsequent to the filing date of the subject application.

As additional grounds for traversal of the provisional double patenting rejection, Applicant respectfully asserts that the Examiner's analysis and reasoning in support of the rejection do not comply with the standards set forth in the M. P. E. P. 804(II)(B)(1) which specifically states:

Any obviousness- type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims -- a claim in the patent compared to the claimed in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the inventions defined in the claim in the issue is an obvious variation of the inventions defined in a claim in the patent.

(emphasis added)

In setting forth the grounds for the rejection, the Examiner has not identified the differences between the inventions claimed in the subject application and the '095 and the '705 applications. Instead, the Examiner has made broad and general statements regarding the "metes and bounds" of the claims. Accordingly, the Examiner has not made a limitation by limitation analysis, identified the differences between the limitations in each of the alleged conflicting claims, and therefore given the Applicant an opportunity to evaluate whether such differences are non-obvious under the Graham vs. John Deere standard.

Finally, Applicant respectfully requests that the provisional double patenting rejection be withdraw and that this application be allowed to advance to issuance. M. P. E. P. 804(II)(B)(1)(b), Examiner's Note (7) to form paragraph 8.35, requires the Examiner to also make a provisional double patenting rejection in the conflicting application(s) (the '095 and '705 applications). Additionally, M. P. E. P. 804(I)(B) further specifically states:

If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should withdraw the rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

Except for the provisional double patenting rejection, based on the telephone interviews with the Examiner since the 10/21/04 mailing of the current Office action, there does not appear to be any remaining issues in the subject application. Accordingly, Applicant respectfully requests that the Examiner withdrawal the double patenting rejection, advance the subject application to issuance, and issue a double patenting rejection in either of the '095 and '705 applications, instead, if the Examiner is still in disagreement after considering Applicants remarks and arguments set forth above.

Claims 13-19, 25, and 27-54 remain rejected under 35 USC Section 102 (b) as being anticipated by any of U.S. Patent No. 5,513,117, hereafter Small, and European Patent application EPO 784 394 A1, Chaturvedi et al., hereafter referred to as Chaturvedi. In addition, claims 13-19, 25, and 27-54 remain rejected under 35 USC Section 102 (e) as being anticipated by U.S. Patent No. 6,453,300, Simpson. In setting forth the rejections, the examiner has repeated the rejections of the prior office action.

In the response mailed July 1, 2004 to the prior office action of April 21, 2004, applicants set forth extensive arguments as to why the claims, as amended therein, distinguished over Small, Chaturvedi, and Simpson, whether considered singularly or in combinations with any other art of record. Accordingly, Applicants respectfully reassert all of the remarks and traversals set forth in prior responses to the extent still relevant to the outstanding rejections, and ask the examiner to consider the following additional arguments.

As stated previously, the present invention discloses a method, system, computer program product, data structure for enabling users to select over a computer network any of a plurality of gifts from a vendor web site and to designate a recipient. The user can then access, from the same site or a different site, a compilation of customizable cards. The user can then independently select any of the cards and personalize the selected card through various modifications. The selected, personalized card is printed at the location where the gift that has been ordered on line is physically located. The personalized card and corresponding gift are matched and combined as a single parcel for shipment to the designated recipient. In the present invention, the gifts are not just gift certificates, but physical entities of different types. Further, the card

and gift combination is not predetermined, i.e. the selected gift does not predefine or limit the selection of cards, nor does the selected card predefine or limit the selection of gift(s). Accordingly, the present invention allows any number of independently selectable, cards to be customizable and matched with any number of selectable gifts, without predetermined limitations, and for the customized card and gift(s) to be sent together as a single combined entity to the designated recipient.

In contrast, the Small, Chaturvedi, and Simpson references, on which the current set of rejections are based, do not provide a personalizable card that can be selected independent of any of a plurality of items ordered on line. Chaturvedi discloses a kiosk based systems, with a limited number of physical gifts. Small discloses a kiosk based systems, with only gift certificate-type or electronically vendable gifts. Simpson discloses a system in which the recipient criteria dictate the card and the variation of the gift type. None of the references on which the current rejections are based disclose the ability to select from a plurality of customizable cards and any of a plurality of on-line accessible gifts, from a variety of vendors, and to have the customized card and gift matched and physically shipped as a single entity to a designated recipient. Additional comments distinguishing the cited references over the claim subject matter are set forth below by reference.

Simpson describes a system for providing a "gift card" and for personalizing the gift card (Simpson, col. 3, lines 19-24). In Simpson, the card device 10 includes a compact disc 62 or other storage medium, a gemstone or birthstone 70 and a sheet of the printable material 76 and 78 insertable into the compact disc case 54 (Simpson, col. 3, line 30 through col. 4, line 15). Essentially, all of these elements comprise the card. In fact, Simpson expressly admits that if the custom "gifting" is desired to be shipped with the gift card, only coupons or vouchers referring to the gift can be utilized, (Simpson, Col.7, line 7-36)

Even if the Examiner considered either the birthstones or the CD as gifts and not parts of the card, in Simpson, the purchaser does not have a choice of stone or the information accessed on the CD. Instead, the recipient information, e.g. the birth date and month, is used as the selection criteria. Further, in Simpson, the customer does not enjoy a full selection of different gift types, but is limited to those few items in

inventory, i.e. birthstones or gemstones, or other item that is of a size and shape which is insertable into the spline portion 12 of the CD case 54 (Simpson, col. 4, lines 44-52).

Applicants are not alone in their interpretation of Simpson. Indeed, the applicant of US provisional patent application 60/249,219, filed November 16, 2002 (published as WO 02/41166 A1) commented on the deficiencies of the Simpson system as disclosed in US patents 6, 453, 300 and an abandoned CIP application thereto (Serial No. 09/773, 726, published as US2001/0005834 A1) with the following excerpts:

An example of such a greeting card/gift combination is disclosed in US patent application publication number US 2001/0005834 A1, published on June 28, 2001. The greeting card/gift combination disclosed therein relates to a greeting card CD, housed in a conventional jewel case. The CD contains generic information which can be customized by an on-line purchaser for a designated recipient. For example, the CD may be provided with birth month information for all 12 months of the year. An on-line customizing feature allows the CD to be customized such that only selected information can be replayed by the recipient. For example, if the designated recipients birth month is September, the on-line purchaser can configure the CD on-line such that only information on the CD pertaining to the month September can be played back by the designated recipient.

* * * *

Unfortunately, purchaser's are limited to the CD as a gift and can not select from the multitude of items available on e-commerce for purchase. Should a purchaser wish to send a designated recipient a gift from an on-line retailer, the purchaser would have to order to gift on-line and have it shipped back to the purchaser. A greeting card would have to be purchased separately and packaged with the gift and re-shipped to the recipient. Thus, there is a need for a system which allows gift items, available from e-tailers, and personalized greeting cards to be packaged together and sent directly from the retailers fulfillment center to a

designated recipient.

(W0 02/41166 A1, Description of Prior Art)

The above excerpts, authored by an independent third party not associated with this proceeding, corroborates and reaffirms applicants current position that Simpson does not disclose or suggest a system in which a customizable greeting card can be selected independent of an item ordered on line from any of the number of on-line vendors, as currently claimed to the present invention.

Chaturvedi discloses a "greeting" booth system in which users interact with the system through a keyboard 110, CRT 120, touch screen 130, drawing pad 140, scanner 150, camera 160, and microphone and speaker 170 to create either electronic or tangible greeting devices. The user, however, is not provided with a facility to access on line, select and customize such greeting devices. Note that the network host 200 is for forwarding an electronic greeting to the electronic mail address of a recipient (Chaturvedi, col. 4, lines 1-7) or instructions to another similar remote assembly mechanism 240 (Chaturvedi, col. 4, lines 52-58). Examiner has not shown, however, where Chaturvedi, discloses a network accessible collection of cards or gifts, as currently recited in claims 18, 19, 25, 29, 31, 35, 36, and 49. In Chaturvedi, once a card has been selected, the customer does not enjoy a full selection of different gift types that are orderable on line, but is limited to those few items in inventory within the kiosk-based system. Accordingly, Chaturvedi does not provide for a personalizable card that can be selected independent of an item ordered on line, and shipped to the same recipient. Accordingly, applicants respectfully asserts that none of the currently pending independent claims are anticipated by Chaturvedi.

Still further, like Simpson, the Examiner has not shown where Chaturvedi discloses a system in which tangible products are delivered simultaneously with either an electronic greeting or a tangible greeting. Chaturvedi specifically indicates that a physical version of a tangible product must be delivered separate from the electronic greeting representing the tangible product (Chaturvedi, col. 3, lines 50-57).

Small discloses a kiosk-like, automated vending apparatus for simultaneously dispensing personalized greeting cards and *electronically* vendable gifts (Small, column

2, lines 30-33). Such gifts are limited to gifts that can be evidenced by an electronically generated personalized printout combined with or printed directly on a personalized card (Small, column 2, lines 55-59). Small does not disclose a system which is capable of simultaneously delivering a personalized greeting card with a tangible gift, since there is no technique disclosed for matching and bundling of the personalized card and the tangible gift. Like Simpson and Chaturvedi, Small does not provide the ability to order on line any of the plurality of items, but instead is limited to only *electronically* vendable gifts. Accordingly, Small does not provide for a personalizable card that can be selected independent of the item ordered on line, as now claimed.

Applicants have previously amended the independent claims. Claims 13 currently recites a data structure for coordinating the combined matching of a card and an item ordered on line from a vendor web site as comprising “data associating the card with the item ordered on line from a vendor web site, *the identified card selected independent of the item ordered on line*” (claim 13, lines 6-8).

Claim 18 currently recites a method comprising “authorizing matching and shipment of the card with the item that has been ordered on line as a combined package, *the identified card selected independent of the item ordered on line*” (claim 18, lines 11-13). In the present invention, the gift selection does not limit the selection of available personalizable cards, and, the card selection does not limit the selection of gift items available on line from vendor(s).

Apparatus claim 19 has been previously amended similar to claim 18. Specifically, claim 19 now recites a method comprising “program logic configured to receive data associating the card with an item that has been ordered on line from a vendor web site, *the identified card selected independent of the item ordered on line*” (claim 19, lines 9-11). Previously added claim 49 is the computer program product counterpart to apparatus claim 19 and has been amended similar to claim 19 (claim 49, lines 8-10).

Method claim 25 has been previously amended to include language similar to amended claim 18. Specifically, claim 25 the recites a method including “printing the card in combination with the modifications at a remote location where an item, that has

been ordered on line from a vendor web site, physically resides, *the identified card selected independent of the item ordered on line*" (claim 25, lines 6-9).

Applicants also further respectfully traverse the rejection of previously added claim 29 as anticipated by any of Small, Chaturvedi, and Simpson for the following reasons. Specifically, claim 29 recites a method including "accessing a card web site from a link associated with the vendor web site" (claim 29, line 6). None of Small, Chaturvedi, and Simpson disclose accessing a card web site from a link associated with the vendor web site, as recited in claim 29, as filed. Chaturvedi also does not disclose an "on line" system as required by limitations (A), (B) and (D) of claim 29. The kiosk in Chaturvedi must be accessed in person, and cannot be accessed online. In addition, Small and Simpson do not appear to access a card web site from a link associated with the vendor web site, as recited in claim 29.

Notwithstanding the above, claim 29 also currently recites a method comprising "authorizing shipment of the printed greeting card, selected from the card web site, with the item ordered online, from the vendor web site, as a combined package to the identified recipient, *the identified greeting card selected independent of the item ordered on line*"(claim 29, line 12-15).

Previously added method claims 31, 35 and 36 have also been amended similar to claims 13,18,19, 25, 29 and 49. Claims 31, 35 and 36 now recite methods comprising "receiving data identifying one of the plurality of greeting cards, *the identified greeting card selected independent of the item ordered on line* " (claim 31, lines 7-8; claim 35, lines 9-10; claim 36, lines 9-10). Accordingly, claims 31, 35 and 36 are believed allowable over the art of record for at least the same reasons as claims 13,18,19, 25 and 49, as well as for the merits of its own respective limitations.

The Examiner has not shown where any of Small, Chaturvedi, and Simpson, or the other references of record, whether considered singularly or in combination disclose Applicants' system, as now claimed in claims 13, 18, 19, 25, 29, 31, 35, 36, and 49. Accordingly, claim claims 13, 18, 19, 25, 29, 31, 35, 36, and 49, as well as their respective the dependent claims, where applicable, are believed allowable, over Small, Chaturvedi, and Simpson, or the other references of record, whether considered singularly or in combination.

Further, in setting forth the rejection, the Examiner has cited specific sections of Small, Chaturvedi, and Simpson which are alleged to disclose the limitation of all the claims. After review of the cited portions of Small, Chaturvedi, and Simpson, Applicants respectfully traverse the rejection as improper. Specifically, to anticipate a claim, a reference must teach every element of the claim (MPEP Section 2131). As to claims 37, 39-40, and 50-51, the Examiner has failed to indicate where any of Small, Chaturvedi, and Simpson disclose the limitation of "program logic configured to present an image of the card in combination with the received modifications to the card in WYSIWYG format" (claim 40, lines 2-3; see also claim 30, lines 2-3; claim 37, line 2; and claim 51, lines 2-3). The Examiner will note that the Figure 6 of Simpson is not WYSIWYG presentation of the image of the card in combination with the received modifications. The legends associated with the card graphics and figure six of Simpson says quote the card which accompanies the Greets CD you are about to create will look alot like this on the inside" (Simpson, Figure 6). A WYSIWYG presentation of an image is an exact image of what will be printed. Simpson's explicit indication in using the term "alot" provides evidence that the illustrated graphic is only an approximation and not an exact WYSIWYG image. In addition, the Examiner has failed to indicate where any of Small, Chaturvedi, and Simpson disclose the limitation of "program logic configured to present an image of the card in combination with the received modifications to the card" (claim 39, lines 2-3; see also claim 50, line 2). A presentation of just the text portion of a card is not an image of the entire card, as in the present invention. Such limitations are disclosed in great detail in the subject specification (page 19, line 14 through page 20, line 19; see also Figs. 6A-D). Accordingly, Applicants respectfully assert that claims 30, 37, 39-40, and 50-51, in their current form, are not anticipated by any of Small, Chaturvedi, and Simpson, and, therefore, allowable over the art of record, whether considered singularly or in combinations.

Further, Applicant's attorney reminded the Examiner that following Applicants' response to the office action dated August 26, 2003 in which claims 1-12 were canceled, claims 13-19 and 25-28 were amended, and claims 29-50 were added, Tackbary et al. has not served as a reference in any of the rejections set forth in the last two office actions.

The arguments set forth herein have been offered to advance this application to issue. None of the amendments made previously to the claims should be construed as an admission that the subject matter of the claims, as originally filed, is anticipated by or made obvious in light of any art of record whether considered singularly or in combinations. Applicant expressly reserves the right to pursue the originally filed claims in another co-pending application without being prejudiced by any amendments, including cancellation of claims, made herein.

Applicants believe the claims are in allowable condition. A notice of allowance for this application is solicited earnestly. If the Examiner has any further questions regarding this amendment, he/she is invited to call Applicant's attorney at the number listed below. The Examiner is hereby authorized to charge any fees or credit any balances under 37 CFR §1.17, and 1.16 to Deposit Account No. 02-3038.

Respectfully submitted,


Bruce D. Jobse, Esq. Reg. No. 33,518
KUDIRKA & JOBSE, LLP
Customer Number 021127
Tel: (617) 367-4600 Fax: (617) 367-4656

Date: 2/22/05